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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,320	04/05/2005	Guido Bieker	01117.0011.PCUS00	3632
32894	7590	06/19/2007		
HOWREY LLP C/O IP DOCKETING DEPARTMENT 2941 FAIRVIEW PARK DR., SUITE 200 FALLS CHURCH, VA 22042			EXAMINER BURCH, MELODY M	
			ART UNIT	PAPER NUMBER
			3683	
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			06/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,320	<b>Applicant(s)</b> BIEKER, GUIDO	
	<b>Examiner</b> Melody M. Burch	<b>Art Unit</b> 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/5/05, 5/9/07.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) 4,6,7,9,12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,8,10,11,14-19 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-19 and 21 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/2/06</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 4, 6, 7, 9, 12, and 13 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/9/07.
2. Applicant's election with traverse of species II in the reply filed on 5/9/07 is acknowledged. The traversal is on the ground(s) that there is a common inventive concept. This is not found persuasive because there are varying tilt arrangements distinguishable by their distinct structures. Since the tilt structures are different, Examiner maintains that there is no common inventive concept. Accordingly, the requirement is still deemed proper and is therefore made FINAL.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5, 8, 10, 14, 17, 18, 19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 2207295 to Latshaw.

Re: claims 1, 2, 5, 14, 19, and 21. Latshaw shows in figures 5 and 6 a magnetic rail brake for a rail vehicle shown in figure 3 comprising: a magnet supported from the rail vehicle, a guide assembly to guide the magnet for movement in a substantially vertical plane while allowing limited lateral movement, and an extension arm 74, the extension arm arranged to contact the rail vehicle at a distance from the magnet which is substantially greater than either the maximum extent of vertical movement or the maximum extent of lateral movement of the magnet to thereby reduce tilting of the magnet as shown.

Re: claim 3. Latshaw shows in figure 6 the limitation wherein the extension arm comprises a first stop surface 76.

Re: claim 8. Latshaw shows in figure 4 and discloses on pg. 2 lines 31-35 the limitation wherein the extension arm comprises adjustable stop means.

Re: claims 10 and 18. Latshaw discloses an actuation device connected to leads 45 causing the magnet to be attracted to a rail on which the rail vehicle travels.

Re: claim 17. Latshaw shows in figure 3 the limitation of the magnet being supported by suspension device comprising a compression or tension spring 60.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3683

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Latshaw in view of SU-998307 (SU'307).

Latshaw describes the invention substantially as set forth above, but lacks the limitation of a tilt detection device.

SU'307 teaches in the English abstract the use of a tilt detection device 1, 2, 3, 4.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the rail brake of Latshaw to have included a tilt detection device to determine the actual position of the brake in order to actively and accurately adjust the position as needed.

8. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Latshaw.

Latshaw describes the invention substantially as set forth above, including the limitation of constraining tilt, but is silent as to the exact range of constraint. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents: 3897117 to Katzer and 4038928 to Degen teach the use of magnetic rail brakes.

Art Unit: 3683

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mmb  
June 11, 2007

*Melody M. Burch*  
*Melody Burch*  
*Primary Examiner*  
*6/11/07*